

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Silvia FONQUERNA POU, et al.)	Group Art Unit: 1625
)	
Application No.: 10/509,279)	Examiner: David E. Gallis
)	
§ 371 Filing date: May 5, 2005)	Confirmation No.: 1079
)	
For: AZAINDOLYLPIPERIDINE)	
DERIVATIVES AS)	
ANTIHISTAMINIC AND)	
ANTIALLERGIC AGENTS)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action dated March 12, 2008, the Examiner required restriction under 35 U.S.C. §§ 121, 372 among the claims of Groups I to XIII¹.

Applicants elect to prosecute the claims of Group I, claims 1, 2, 3, 5-22, and 28.

Applicants respectfully remind the Examiner of the rejoinder procedure of M.P.E.P. § 821.04. This section of the M.P.E.P. provides that claims directed to a nonelected processes of making or using a product are subject to rejoinder with claims drawn to that product once the product is found patentable. *See also In Re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996). The M.P.E.P. requires that "[i]n order to be eligible for

¹ The Office Action listed two instances of "Group XII." Office Action at 3. Applicants believe that the second recitation of "Group XII" should have referred to "Group XIII" instead.

rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim." *Id.*

Applicants point out that the claims of Groups IV and XI, which are directed to methods of making a compound as claimed in claim 1 and methods of treating comprising administering a compound as claimed in claim 1, respectively, comply with this provision. Therefore, these claims are eligible for rejoinder once the compounds of claim 1 are found patentable. Accordingly, pursuant to this rejoinder procedure, Applicants respectfully request that claims of Groups IV and XI be examined together with the claims of Group I in this application.

Additionally, Applicants note that given the structures of the compounds of claims 1 and 26, it would not be burdensome to perform a search for the compounds of claim 26 when performing the search for the compounds of claim 1. Thus, Applicants respectfully request that claim 26 be also examined in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

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Dated: April 14, 2008